

### **REMARKS/ARGUMENTS**

Applicant respectfully requests reconsideration of the present application in view of the following reasons. Claims 1-77, 83-91, 111-116, 138-159, and 162-165 have been previously canceled. Claims 78, 92, 117 are requested to be amended to improve their clarity and grammar. Therefore, no new matter has been added, and no new search is required by the Examiner. As a result, Applicant respectfully requests entry of the amendments. As such, Claims 78-82, 92-110, 117-130, 132-137, 160, and 161 are pending in this application.

#### **I. Claim Rejections Under 35 U. S. C. § 103(a)**

##### **A. Claims 78-82, 92, 93, 95, 96, 102-104, 106-110, 117-122, 124-131, 133-137, 160, 161**

In section 3 of the Office Action, Claims 78-82, 92, 93, 95, 96, 102-104, 106-110, 117-122, 124-131, 133-137, 160, and 161 were rejected under 35 U. S. C. § 103(a) as being unpatentable over United States Patent No. 5,438,355 to Palmer (hereinafter “Palmer”) in view of United States Patent No. 5,382,970 to Kiefl (hereinafter “Kiefl”) and further in view of United States Patent No. 5,410,326 to Goldstein (hereinafter “Goldstein”). Applicant respectfully traverses the rejection.

- (i) Whether considered separately or in any combination, Palmer, Kiefl, and Goldstein fail to teach, describe or suggest the time-of-day information as claimed

Claim 78 recites “storing, in the memory, time-of-day information corresponding to a time at which the request is received,” wherein the time-of-day information is provided by the clock.” (Emphasis added). Claims 92 and 117 each recite “a controller” configured to “store time-of-day information from the clock in the memory, wherein the time-of-day information corresponds to a time at which a request for the supplemental information is received” through the user control. (Emphasis added). By contrast, Palmer, Kiefl, and Goldstein fail to teach, suggest, or describe at least these elements.

As the Examiner has agreed, Palmer fails to disclose a clock outputting time-of-day information. It follows that Palmer also fails to disclose “storing ... time-of-day information corresponding to a time at which the request is received,” as recited in Claim 78, or a controller configured to store “time-of-day information [which] corresponds to a time at

which a request for the supplemental information is received,” as recited in Claims 92 and 117.

However, the Examiner has relied upon col. 6, lines 38-51 of Kiefl, and asserts that Kiefl teaches such elements. Applicant respectfully disagrees. The cited portion of Kiefl states that:

The channel detector in interface 22 provides a signal to microprocessor 23 representing the channel of record and microprocessor 23 stores the information in a location in a memory 28, together with data on the *beginning time and end time at which the channel was selected by remote control* 10 (FIG. 1) or, initially, by manual input to the personal data meter 16 if, for example, the television is already operating when the viewer enters the room. However, to avoid recording times for each channel selected when a viewer is scanning through a number of channels, *it is desirable not to provide a record of channels selected for less than a preset short time*, say for example, five seconds or less. With this exception, the data is stored in memory 28.

(Emphasis added.) From the above passage, it is clear that Kiefl teaches storing a *beginning time and end time at which the channel was selected by remote control* while excluding *channels selected for less than a preset short time*. Thus, Kiefl discloses storing *time windows* defined by a beginning time and an end time. Such time windows cannot be short, for example, less than five seconds. If the time windows are less than five seconds, they are not stored. Contrary to the Examiner’s assertions, Applicant respectfully submits that the time windows disclosed in Kiefl are clearly different from “time-of-day information **corresponding to a time at which the request is received,**” as claimed. (Emphasis added.) Further, the time windows disclosed in Kiefl teach away from the claimed invention and would make the claimed invention inoperable. For example, it may take less than five seconds to make a request, and for the time-of-day information corresponding to a time at which the request is received to be stored. Employing the system of Kiefl in an attempt to arrive at the claimed invention would cause many of the “requests,” and subsequently the “supplemental information,” to be lost because the time windows of Kiefl are in excess of five seconds.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of Claims 78, 92, and 117. For at least the same reasons, Applicant also respectfully requests withdrawal of the rejection of Claims 79-82, which depend from Claim 78, Claims 93, 95, 96,

102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117.

- (ii) Goldstein does not disclose “supplemental information about a broadcast” as claimed

On page 6 of the instant Office Action, the Examiner has agreed that Palmer and Kiefl fail to disclose the “supplemental information” as claimed. However, on page 7 of the instant Office Action, the Examiner has relied upon Fig. 6A of Goldstein, and asserts that Goldstein teaches the claimed “supplemental information about a broadcast.” Applicant respectfully disagrees.

Goldstein is directed toward “a universal programmable remote control device which may be used by a consumer for controlling a variety of consumer products.” (Col. 3, lines 14-17). Goldstein discloses that the remote control includes “various input ports 26, 27 and 28” such that “embedded data in a television broadcast” is transferred “to the remote control device.” (Col. 7, line 67 – col. 8, line 1). The remote control includes “a real time clock 16.” (Col. 7, lines 37-38). Fig. 6A of Goldstein merely shows advertisement information for a future show. Col. 11, lines 15-26 of Goldstein clarifies what the content of the displayed information is directed toward:

A touch screen associated with the remote control device has additional features to be implemented. For instance, the full display screen can be used to display advertisements, such as shown in FIGS. 6, 6A, 7, 7A, 8 and 8A downloaded from the cable TV head end via a two-way communications link linking the remote control device and cable converter. As will be evident from the block diagrams representing the cable converter 6 and universal remote control device 5, messages relayed to the set top converter 6 from the head end cable facility *may be downloaded to the remote control device for display.*

(Emphasis added.) From the above passage, it is clear that, contrary to the Examiner’s assertions, the displayed advertisement information as shown in Fig. 6A of Goldstein is not the same as “supplemental information **about** a broadcast” as claimed. Rather, such advertisement information, which includes isolated segments dispersed in a broadcast and which may optionally be downloaded, is not “about” the broadcast, nor is it associated with the broadcast.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of Claims 78, 92, and 117. For at least the same reasons, Applicant also respectfully requests withdrawal of the rejection of Claims 79-82, which depend from Claim 78, Claims 93, 95, 96, 102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117.

- (iii) Kiefl teaches away from the claimed invention, and there is no reason, motivation or suggestion to combine Palmer, Kiefl, and Goldstein

Kiefl is directed toward a “system for monitoring and collecting data on the viewing habits of television viewers or radio listeners ....” (Abstract). Data is collected through “a portable personal data collection device, for use in monitoring audience attention to receivers for receiving broadcast stations ....” (Col. 2, lines 36-39). Kiefl discloses that the data collection device includes “a clock for providing a signal representing time, a memory for storing data ... and a processor means ....” (Col. 2, lines 42-46). The processing means is “responsive to said signal representing the time and to said station identifier for storing in said memory data comprising the time at the beginning and end of receiving signals from said particular one of said broadcast stations ....” (Col. 2, lines 47-51).

As discussed above, Kiefl does not teach or suggest “**storing ... time-of-day information corresponding to a time at which the request is received,**” as recited in Claim 78. (Emphasis added). Kiefl also fails to teach or suggest a controller configured to **store “time-of-day information [which] corresponds to a time at which a request for the supplemental information is received,**” as recited in Claims 92 and 117. (Emphasis added). Storing a start time and an end time to monitor an individual’s viewing/listening habits is not the same as receiving a request for supplemental information or storing time-of-day information corresponding to a time when the request is received.

Further, a prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). As recited in the above-quoted passage of Kiefl, the system of Kiefl *excludes short time periods such as those less than five seconds*. Thus, Kiefl clearly teaches away from the claimed invention. This is evident from, for example, the fact that it may take less

than five seconds to make a request, and for the time-of-day information corresponding to a time at which the request is received to be stored. Employing the system of Kiefl in an attempt to arrive at the claimed invention would cause many of the “requests,” and subsequently the “supplemental information,” to be lost.

Further, if Palmer, Kiefl, and Goldstein were to be combined and the system modified in an attempt to arrive at the claimed invention, the provision in Kiefl of *not providing a record of channels selected for less than a preset short time* would have to be eliminated. The resulting system would be constantly recording times for each channel selected even when a viewer is scanning through a number of channels. This would defeat the purpose of Kiefl, that is, to monitor audience *attention* to receivers for receiving broadcast signals (*e.g.*, col. 2, lines 36-39). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of Claims 78, 92, and 117. For at least the same reasons, Applicant also respectfully requests withdrawal of the rejection of Claims 79-82, which depend from Claim 78, Claims 93, 95, 96, 102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117.

- (iv) The Examiner has identified and chosen isolated features from Palmer, Kiefl, and Goldstein, and used impermissible hindsight in an attempt to arrive at the claimed invention

On page 5 of the instant Office Action, the Examiner combined the purported reporting features of the personal data meter 16 as taught by Kiefl with features of the remote control device as taught by Goldstein (*see, e.g.*, page 7 of the instant Office Action). Applicant respectfully submits that this combination disregards the fact that Kiefl requires multiple personal data meters 16, 17, 18 *separate* from the television remote control 10, and disposed adjacent the television receiver *away* from the remote control 10 (*see, e.g.*, Fig. 1) to serve their purpose of being “personal” (*see, e.g.*, col. 5, lines 33-51).

Indeed, contrary to the assertions made in the instant Office Action (page 5, line 13), the personal data meters 16, 17, 18 disclosed in Kiefl, although “portable,” are *not* intended to be “hand-held electronic devices.” The fact that the Examiner has picked and chosen isolated features from various devices from a large number of references without context, together with the unfounded assertions that “it is simply broadened to be more widely applicable when modified...” (*see, e.g.*, page 10, lines 16-17 of the instant Office Action), are strong indications that the Examiner, aided with the teachings of the present application, has used impermissible hindsight reconstruction in an attempted reverse engineering to arrive at the claimed invention.

For at least the reasons, Applicant respectfully requests withdrawal of the rejection of Claims 78, 92, and 117. For at least the same reasons, Applicant also respectfully requests withdrawal of the rejection of Claims 79-82, which depend from Claim 78, Claims 93, 95, 96, 102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117.

B. Claims 94, 105, 123, and 132

In section 4 of the Office Action, Claims 94, 105, 123, and 132 were rejected under 35 U. S. C. § 103(a) as being unpatentable over Palmer, Kiefl, and Goldstein, and further in view of United States Patent No. 4,955,070 to Welsh et al. (hereinafter “Welsh”). Applicant respectfully traverses the rejection.

As discussed above, whether considered separately or in any combination, Palmer, Kiefl, and Goldstein fail to teach, suggest, or describe at least a controller configured to store “time-of-day information [which] corresponds to a time at which a request for the supplemental information is received,” as recited in Claims 92 and 117.

Welsh is directed toward “a method and apparatus for automatic monitoring of broadcast band listening habits using an electronic monitor.” (Col. 1, lines 44-46). The electronic monitor is configured for “electronically tuning a broadcast band tuner ... until a match is found with ... [an] acoustically sensed signal, and recording the time and frequency” of the match for monitoring the user. (Col. 1, lines 49-53). However, Welsh fails to teach or suggest a controller configured to store “time-of-day information [which] corresponds to a

**time at which a request for the supplemental information is received,”** as recited in Claims 92 and 117. (Emphasis added). Thus, Welsh fails to supply that which Palmer, Kiefl, and Goldstein lack.

For at least these reasons, Applicant respectfully submits that whether considered separately or in any combination, Palmer, Goldstein, Kiefl, and Welsh fail to teach or suggest all of the elements recited in Claims 92 and 117. Accordingly, Applicant respectfully submits that Claims 92 and 117 are in condition for allowance. For at least the same reasons, Applicant also submits that Claims 94 and 105, which depend from Claim 92, and Claims 123 and 132, which depend from Claim 117, are in condition for allowance, and requests withdrawal of the rejection.

C. Claims 97-101

In section 5 of the Office Action, Claims 97-101 were rejected under 35 U. S. C. § 103(a) as being unpatentable over Palmer, Kiefl, and Goldstein, and further in view of United States Patent No. 5,583,763 to Atcheson et al. (hereinafter “Atcheson”). Applicant respectfully traverses the rejection.

As discussed above, whether considered separately or in any combination, Palmer, Kiefl, and Goldstein fail to teach, suggest, or describe at least a controller configured to store “time-of-day information [which] corresponds to a time at which a user request for the supplemental information is received,” as recited in Claim 92. Atcheson is directed toward “a system for determining selections that a user is likely to be interested in.” (Abstract). Atcheson does not teach or suggest a controller configured to store “time-of-day information [which] corresponds to a time at which a request for the supplemental information is received,” as recited in Claim 92. (Emphasis added). Thus, Atcheson fails to supply that which Palmer, Kiefl, and Goldstein lack.

For at least these reasons, Applicant respectfully submits that whether considered separately or in any combination, Palmer, Goldstein, Kiefl, and Atcheson fail to teach or suggest all of the elements recited in Claim 92, and there is no motivation to combine these references. Accordingly, Applicant respectfully submits that Claim 92 is in condition for allowance. For at least the same reasons, Applicant also submits that Claims 97-101, which

depend from Claim 92, are in condition for allowance, and requests withdrawal of the rejection.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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